

REMARKS

The present Amendment and Response is submitted in reply to the Office Action dated May 20, 2008. Claims 5 and 6 were pending in the Office Action. Claims 5 and 6 are amended herein, and remain pending for consideration. As amended, claim 5 finds support at least in previous claim 5 and in paragraphs [0039]-[0040] of the Specification. As amended, claim 6 finds support at least in previous claim 6 and in paragraph [0058] of the Specification. No new matter is added.

In the Office Action, the following rejections were made:

Claim 5 was rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the invention, in particular, for omitting steps considered essential by Examiner; and

Claims 5 and 6 were rejected under 35 USC § 102(e) as anticipated by Yajima (U.S. Patent No. 6,539,986, filed September 7, 2001).

Applicants respectfully traverse these rejections below.

Rejection of Claim 5 Under 35 USC § 112

As amended, claim 5 recites a deaerating method of a chemical liquid supply apparatus having a pump discharging a liquid, the deaerating method comprising a sucking operation of said pump under such a state that said pump-inlet side valve is opened and that said pump discharge-side valve is closed, and a discharging operation of said pump under such a state that said pump-inlet side valve and said discharge valve are closed and that said pump discharge-side valve is opened, along with subsequent operations previously recited.

Thus, amended claim 5 incorporates the sucking and discharge operations deemed to be essential recitations by Examiner. Accordingly, Applicants respectfully request that the rejection of claim 5 under 35 USC § 112(2) be withdrawn.

Rejections Under 35 USC § 102

Claims 5 was rejected under 35 USC § 102(e) as anticipated by Yajima (U.S. Patent No. 6,539,986, filed September 7, 2001).

An anticipation rejection is improper unless a single prior art reference shows or discloses *each and every claim limitation*. MPEP § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Yajima at least fails to show or disclose either an operation of a pump under such a state that a deaeration valve provided to an exhaust flow path communicating with an inlet side of said filter, said pump inlet-side valve, and said discharge valve are closed and that said pump discharge-side valve is opened; *or* an operation of said pump under such a state that said deaeration valve and said pump discharge-side valve are opened and that said pump inlet-side valve and said discharge valve are closed, as recited by amended claim 5.

In particular, the time graph in Figure 6 of Yajima shows that, during the time between segments S₁ and S₂ of the operation, *each* of an inflow side valve 8, a pressure regulating valve 9, a discharge side valve 15, and a nozzle opening/closing valve 16 is *closed*. Thus, Examiner's referenced time segment fails to disclose an operation of a pump under a state that a deaeration valve, a

pump inlet-side valve, and a discharge valve are *closed* and a pump discharge-side valve is *opened*, as recited by claim 5.

Similarly, the time graph in Figure 6 of Yajima shows that, during the time segment S₁ of the operation, *each of* an inflow side valve 8, a discharge side valve 15, and a nozzle opening/closing valve 16 is *closed* while a pressure regulating valve 9 is *open*. Thus, Examiner's referenced time segment fails to disclose an operation under a state that a deaeration valve and a pump discharge-side valve are *opened* and a pump inlet-side valve and a discharge valve are *closed*, as recited by claim 5.

Further, Applicants note that a prior art device, in its normal and usual operation, must *necessarily* perform the method claimed in order to support a rejection under 35 USC § 102 based on inherency. (See MPEP § 2112.02, Process Claims). Although the apparatus disclosed by Yajima *may be capable* of performing the operations discussed above, mere *capability* is not sufficient basis to show *inherent* disclosure. See *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999).

For at least these reasons, Yajima fails to show or disclose the process recited by claim 5.

For at least these reasons, the rejection of claim 5 under 35 USC § 102(e) is improper. Accordingly, Applicants respectfully request that the improper rejection be withdrawn.

Claim 6 was rejected under 35 USC § 102(e) as anticipated by Yajima. However, Yajima fails to show or disclose at least a system control section configured to close said deaeration valve, said pump inlet-side valve, and said discharge valve and to open said pump discharge-side valve while performing a

sucking operation of said pump, and configured to open said deaeration valve and said pump discharge-side valve and to close said pump inlet-side valve and said discharge valve while performing a discharge operation of said pump, as recited by amended claim 6. Examiner's attention is respectfully directed to the above discussion of Yajima with reference to claim 5.

For at least the reasons stated, the rejection of claim 6 under 35 USC § 102 is improper. Accordingly, Applicants respectfully request that the improper rejection be withdrawn.

Conclusion

As Applicants have traversed each and every rejection raised by Examiner, hereby it is respectfully requested that Examiner withdraw these rejections and pass claims 5 and 6 to issue.

Applicants believe that no additional fees are due in connection with this Amendment and Response. If such additional fees are deemed necessary, or if any overpayment obtains, Attorneys for Applicants hereby authorize the Commissioner to deduct such fees from or to credit such overpayment to our Deposit Account 13-0235.

Respectfully submitted,

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